

REMARKS

By this amendment, Applicants have amended claims 12, 17, 20, 24, 28, 29, and 31. As a result, claims 12-33 are pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

In the decision on appeal, the Office affirms the Examiner's rejections of claims 12-27 and 29-33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske) and the Examiner's rejection of claim 28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of U.S. Patent No. 5,873,073 (Bresnan).

In affirming the Examiner's rejections, the Board cites a font database of Adamske as allegedly disclosing configuration information that is used in conjunction with a print file to generate a preview of a configured copy of the document as in claim 17. While the Board states that the font database of Adamske is used to generate the print file, the Board still maintains that the font database is used in conjunction with this print file to generate a preview. By this response, Applicants have amended claim 17 to clarify that the configuration information defines how to assemble a printed copy of the document. Applicants respectfully submit that the font database of Adamske fails to teach or suggest such information. Applicants have included similar limitations in independent claims 24, 28, 29, and 31.

In affirming the Examiner's rejection of claim 24, the Appeal Board defines the claim term "based on" as meaning "any association with." By this response, Applicants have amended claim 24 to clarify that the means for assembling the copy assembles the copy as defined by the configuration information. Applicants respectfully submit that the font database of Adamske neither teaches or suggests information that defines how to assemble a printed copy of the document.

With respect to claim 12 and 20, Applicants have amended these claims to expressly state that the configuration information defines finishing and binding options for a printed copy of the document. Applicants submit that Adamske's font database fails to teach or suggest any such limitation.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/John LaBatt/

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